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IN THE
Supreme Court of the United States

October Term 1936.

No. **72**

CROWN CORK & SEAL COMPANY, INC.,
Petitioner,

vs.

FERDINAND GUTMANN & CO.,
Respondent.

**Brief for Respondent in Opposition to Petition for
Writ of Certiorari.**

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IN THE
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October Term, 1936.

CROWN CORK & SEAL COMPANY, INC.,
Petitioner,

vs.

FERDINAND GUTMANN & Co.,
Respondent.

Brief for Respondent.

The petition is for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit to review an order entered by that Court in an ordinary patent suit involving the question of validity and infringement of six United States Letters Patent. An additional patent was set up by respondent as a counterclaim which was dismissed.

The decree of the District Court for the Eastern District of New York held two of the patents which were for Bottle Seals and one of which was for Strip Material for use in making Bottle Seals, invalid, and held one Bottle Seal patent and two patents for Method of Making such Bottle Seals valid and infringed.

No appeal was taken from the decision of the District Court as to the Strip Material patent.

The Circuit Court of Appeals affirmed the decision of the District Court as to the two Seal patents held invalid, and reversed that Court as to the validity of the other Seal patent and one of the Method patents, and as to infringement of the other Method patent, holding against infringement.

The petition seeks to review only that part of the decree of the Circuit Court of Appeals which held one of the method patents invalid and the other one not infringed.

The Circuit Court of Appeals denied a petition for rehearing.

The petition is opposed on the following grounds:

1. There is no conflict between different Circuit Courts of Appeals. This is the only suit ever adjudicated under any of the six patents upon which the suit was based.
2. None of the patents in suit is of any unusual or general interest. Therefore no public interest is involved in the suit.
3. There is no new point of law involved in the decision of the Circuit Court of Appeals.
4. The decision of the Circuit Court of Appeals is not in conflict with any doctrine established by this Court.
5. There is no important question of Federal law involved in the case which has not been, but which should be, settled by this Court.
6. There is no doctrine set forth in the decision of the Circuit Court of Appeals which is probably in conflict with applicable decisions of this Court.
7. While petitioner asserts that the Circuit Court of Appeals has not correctly applied decisions of this Court to the facts of this case, though at the same time arguing that important questions of Federal law are involved which have not been, but which should be, settled by this Court, such assertion is the usual one, made by every unsuccessful litigant finding himself aggrieved because of an adverse decision

by a Court, and does not constitute, "special and important reasons" for the granting of the writ of certiorari referred to in Rule 38-5 (b) of this Court.

8. An inspection of the decisions of both the lower Courts show that the real questions involved were the usual ones of validity and infringement.

9. As to one of the patents, the doctrine of laches, equitable estoppel and intervening rights applies, but the law applied to the facts by the Circuit Court of Appeals is well settled and in strict accordance with the principles of law laid down by decisions of this Court on somewhat analogous facts. As to the other method patent, the only question is that of infringement, which is a question of fact.

10. The petition and brief in support thereof contains many inaccuracies and omissions.

11. It is only by a partial and inaccurate statement of the facts shown by the entire record that petitioner is enabled to present even a plausible argument asking for the review of this Court, and the two so-called "questions presented" on page 9 of the Petition are not warranted by the Record.

12. A review of the record bearing upon the only two patents now in controversy shows conclusively that the questions petitioner seeks to review are purely questions of fact and not of law.

Argument.

The record is voluminous. As pointed out, six patents were originally involved, four for an article and the two patents in controversy for a method of making spot crowns. Three of the article patents were held invalid by the District Court and the fourth by the Circuit Court of Appeals.

In order to bring before this Court the salient facts upon which the Court of Appeals based its decision and correctly applied the principle of law laid down in *Webster Co. v. Splittdorf Co.*, 264 U. S. 463, and to show that there is no basis in the Record for the two questions presented on page 9 of the petition, it is necessary to refer somewhat at length to the record.

The two method patents in controversy and the state of the art as to the subject matter thereof.

The use of crown caps for bottling beverages and the necessity for using center spots are fully set forth in the decision of the Circuit Court of Appeals (p. 2146 Rec.) by Judge Swan who wrote the majority opinion. Judge Manton dissented therefrom, without opinion (p. 2155 Rec.)

The record shows that center spots have been cut from strip material and applied to an assembled crown cap by means of an interposed heat fusible adhesive by the application of heat and pressure since 1915 (p. 482-3 Rec.).

The two method patents involved, viz., Reissue 19,117 and 1,967,195 are each for a method of cutting the center spot from a strip of material either metal foil or paper coated with a heat fusible adhesive, and securing it to the cork disc by means of heat and pressure.

As previously stated the District Court found the patent to Warth 1,899,782 for strip material coated with a heat fusible adhesive invalid over the prior art (p. 2068 Rec.) Petitioner did not appeal from that decision (p. 2146 Rec.)

In order to have a center spot cut from a strip of material coated with a heat fusible adhesive, securely affixed to the cork disc, it is necessary to soften the adhesive by heating and apply pressure to make it adhere to the cork disc.

The patent to Warth Reissue 19,117 shows a method of supplying sufficient heat and pressure by means of a heated cutting punch which cuts out the center spot and sticks it to the cork disc by the simultaneous application of heat and

pressure. The claims are so limited, by the proceedings in the Patent Office and the action of the patentee.

The Warth Patent No. 1,967,195 describes and claims a method whereby the necessary heat is obtained by preliminarily heating the cork disc and then using a cold cutting punch to cut the spot from the strip of adhesive material and then applying pressure.

The record shows that a crown cap or metal shell containing a cork disc, secured to the metal shell by means of a heat fusible adhesive subjected to heat and pressure, were old as far back as the Painter patent of 1892, #468,226, page 4, lines 11, 108-128 (p. 1746 Rec.) Center spots secured to the cork disc by means of a heat fusible adhesive by the application of heat and pressure date back to 1915. Center spots per se were even older (Pats. to Demuth, pp. 1907-9; Nielsen 1,195,392, pp. 1927-8, Rec.). The use of plungers to cut and secure the spot was old. (Pat. to McManus 1,402,780, p. 1421; Alberti 1,401,300, p. 1449 Rec.). The use of a metal foil or strip from which the spots were cut, coated with a heat fusible adhesive is concededly old. Petitioner so conceded when it failed to appeal from the decision of the District Court holding Warth patent #1,899,782 invalid over the art.

Warth, the patentee of both patents in controversy, filed an application for patent on "Bottle Caps" Aug. 21st, 1926 (five months before the filing of the original application for the patent 1,788,260 which is the parent case upon which the reissue is based). That application (which was abandoned) bore Serial No. 130,631 and as originally filed stated (p. 2015 Rec. Vol. 3.).

"This paper disk is then secured to the cork disk by means of a backing 16 of some elastic and adhesive tissue, e. g. gutta percha, by means of a heated plunger or the like. By so applying heat and pressure to the assembled cork and paper disks the gutta percha or like backing is rendered adhesive and the paper spot is firm-

ly cemented to the cork. *In this connection, it is noted that apparatus for cutting and assembling spot-centers is known in the art.*"

The patent to Alberti #1,199,026, application filed October 2, 1914, states on page 2 lines 35 to 43 (p. 1267 Rec. Vol. 2)

*"The cementing medium is applied either to the exposed face of the sealing disk or packing of cork or the like, or it may be spread over that surface of the metallic disk that is to be in contact with the packing, or it may be carried by a layer of fibrous material that is to be interposed between the two disks," * * * the entire closure being put, if necessary, under pressure and heated, whereby the cementing medium is coagulated, holding thus the metallic disk in place."*

The patent to McManus #1,339,066, application filed November 17, 1915 states at lines 20 to 35 of page 2 (P. 695 Rec. Vol. 2) that the center spot is secured to the cork disc ordinarily by the use of a fusible binding medium interposed between the cap and the disc "and set in a manner to unite the parts by the application of heat and pressure simultaneously or successively." The McManus patent was held invalid over the art by the Circuit Court of Appeals (p. 2149 Rec.).

The application for patent #1,967,195 became involved in interference with Johnson patent, No. 1,852,578 (Interference #66,201) discussed later, and the Examiner of Interference in a decision in that interference stated, page 868 (Vol. 2, fol. 2603):

"Attention has been called to the patents to McManus #1,402,780 and Aberti 1,401,300, showing machines for this purpose. In these machines the caps are passed intermittently in single file beneath a reciprocating punch, which cuts the metal foil disk from a strip and deposits it upon the cork pad. The caps then pass to an immediately adjacent heated plunger which applies sufficient heat and pressure to complete the union. It was agreed by both parties at the hearing that machines of this character were used commercially prior to 1927 and that they operated at high speed."

The petitioner, on the trial of the cause, produced evidence to show that as early as 1915 it had a machine known as the "slide machine" for affixing the center spot to the cork disc (p. 482-4). A drawing of the machine (Ex. 43) was put in evidence by petitioner (p. 789 Rec.). A letter (Ex. 44, pp. 791-2 Rec. Vol. 2) from the head of the petitioner's engineering department states in part:

"A Crown has now come into position under the Plunger and Heater 'H' which has moved into position relative to applying the spot to the crown. This is accomplished by the action of the pump 'B', which on its return stroke blows the spot from its position in the Heater on to the Crown which is *then pressed on to the cork in the crown by the Heater Plunger*. This completes the cycle of operations necessary for applying the Tin Foil Spot to the assembled #1 Crown."

The District Court, (p. 2081 Vol. 3 Rec.) in discussing that machine said

"The *pressure of this heated punch* caused the gutta percha to stick to the cork and also to the foil spot."

There is therefore nothing new about the method claimed by either of the method patents in controversy.

Both of these patents should have been held invalid in view of the decision of this court in the case of *Altoona Theatres vs. Tri-Ergon Corp.*, 294 U. S. 477, page 486.

The District Court found the reissue patent 19,117 valid and infringed. The Circuit Court of Appeals held the patent not infringed.

The construction of the claims of the reissue 19,117 by the Court of Appeals was correct.

Counsel for petitioner (p. 16 and 26 brief) alleges the Court of Appeals erroneously construed the claims as limited to the heated plunger, and states in support of his argument the

decision of this court in the case of *Altoona vs. American Tri-Ergon*, 294 U. S. 477, 487. The argument is wholly without merit. In the case at bar the court of appeals very properly said (p. 2152 Rec.) :

"To read the claims of the reissue patent to mean a cold punch to cut the spots and a hot plunger applied later to fasten it to the cork disc would make them invalid under the old 'slide machine.' To read them to mean a cold punch which positions the spot upon a preheated cork would be inconsistent with the fact that the preheating specification was deliberately divided out later claimed in Warth's 'preheating patent' hereafter to be discussed."

Reference has already been made on page 7 of this brief to the slide machine used by petitioner beginning 1915. In addition reference is made to the other heat and pressure patents of the prior art discussed on pages 5-6 of the brief. If there is any novelty in reissue patent 19,117 over the disclosures of the prior art patents referred to, the claims, if valid at all must be limited to the precise method shown and described.

It is elementary that when a patentee acquiesces in the rejection of a claim during the progress of an application he cannot thereafter have a construction of the allowed claim which he accepted which will cover the matter he was forced to disclaim.

That law applies here with particular force. Warth voluntarily restricted himself, in his application 159,743 to the use of a heated plunger, and cannot two and one-half years after the cancelled matter has become public, claim a construction of the allowed claim to cover the cancelled matter.

The Altoona Theatres vs. Tri-Ergon Corp. case, relied upon by petitioner, shows page 487 that the finding of the Court of Appeals in that case was reversed by this court upon grounds which have no application to the facts in the case at bar.

Counsel for petitioner argues on pages 7 and 16 of his petition and brief in support thereof, that the Warth reissue patent 19,117 covers both methods of heating viz; heating the plunger and also preliminarily heating the cork before the spot is cut.

If he is correct in that contention then the second patent is necessarily void. There cannot be two patents for the same invention.

Miller vs. Eagle Mfg. Co., 151 U. S. page 186;

Underwood v. Gerber, 149 U. S. 224;

Powder Co. v. Powder Works, 98 U. S. 126 and 137.

It is true that the District Court held (pp. 2081-2 Rec.) that the Warth reissue patent covered both methods. The District Court also held (p. 2102 Rec.):

"None of the claims of the divisional patent (1,967-195) is readable upon the disclosure of the reissue etc."

It is submitted that that finding of the District Court is clearly erroneous and inconsistent with its prior holding that the reissue patent covered both methods.

The Circuit Court of Appeals very properly reversed this holding and held that the Reissue patent 19,117 was restricted to the precise method of obtaining the necessary heat by heating the cutting plunger.

Hubbell v. U. S., 179 U. S. 77 at 83-4;

Leggett v. Avery, 101 U. S. 256 at 259;

Kokomo Fence Machine Co. v. Kitselman, 189 U. S. 8;

Weber Electric Co. v. Freeman, 256 U. S. 668.

There is no proof of infringement of Reissue Patent No. 19,117.

The petitioner produced no evidence of any kind at the trial to show that respondent infringed the claims of the

reissue patent calling for the simultaneous application of heat and pressure at the time of assembly.

The only evidence of infringement of either patent shows that the petitioner's officers and counsel called at the respondent's factory August 8, 1933 (pp. 301 and 683 Rec.) for the purpose of discussing a settlement and were shown respondent's method being used by respondent at that time, which was the method of the Johnson patent 1,852,578 as modified by the procedure called for by Cohn patent #1,921,808 which also called for preheating the cork disc and used a cold cutting punch. That Cohn patent was the subject of respondent's counterclaim. The method claims of said Johnson patent are now the method claims of #1,967,195 viz., preheating the cork and applying the center spot by a cold punch.

The only evidence as to the method used by respondent was that given by respondent's superintendent and manager, both of whom emphatically stated that the respondent had always preheated the cork disc and never had used a hot cutting punch. *It had always used a cold cutting punch only* (pp. 287 & 375-6, Rec.).

The testimony of the witnesses for respondent Benno Cohn and Chas. Rasmussen, was to the effect that, beginning in December 1924 and ending in March 1925, the respondent had made and sold to the Inecto Company upwards of 300,000 caps having metal foil center spots secured to the cork disc by means of gutta percha which is a heat fusible adhesive by the application of heat and pressure.

The testimony of these witnesses shows that the method respondent used was as follows:

In December 1924 and January 1925 it used an old Clark-Johnson assembling machine (a machine for assembling the cork disc in the metal crown without a center spot) put a center spot cutting attachment thereon and preheated the cork by means of gas jets adjacent a chute which carried the assembled crowns to the spotting attachment where the center spots were secured to the cork disc by heat and subsequent cold pressure. That testimony on its face invalidates both

of the method patents now under review because (if reissue 19117 is to be so construed as to include preheating the cork disc) respondent used this method more than two years before the filing of the application for either method patent.

The testimony of these two witnesses was substantiated by officers of the Inecto Company who not only recollected that the caps were so made, but identified invoices rendered by respondent to that company and produced correspondence showing beyond all question that respondent made and sold the caps to that company on the dates mentioned. Only 300,000 were made and then discontinued because the Inecto Company sold a hair tonic having an ingredient which it was afraid might be deleteriously affected by the gutta percha, and it decided to use a cap with a flanged metal center spot forced into the cork disc as disclosed by Patent to Nielsen 1,195,392 (p. 1921 Rec.). It was further substantiated by people who sold the gutta percha and tin foil strips to respondent (pp. 211-13; 256-7 & Exs. H to O & NN to TT, pp. 1170-86 Rec.).

The District Court disregarded the testimony of Cohn and Rassmussen as to the method, stating in its opinion (pp. 2078-9) that it believed they were honestly mistaken and there was not sufficient corroboration of the method either by the production of the original machine nor of any caps alleged to have been made at that time.

The District Court, however, found as a matter of fact that the respondent did make the caps at the dates mentioned and stated that "it was known to the art" (p. 2067 Rec.).

The Circuit Court of Appeals, with this evidence before it, made no specific finding either way on the question of this prior use. It did, however, accept it to the extent that it held that the method used by defendant was that of a cold plunger and therefore did not infringe the claims of the Reissue Patent No. 19,117 which are restricted to the method of applying the heat and pressure simultaneously to the cork disc when the center spot is cut out by means of a heated plunger.

Neither party uses a heated cutting punch as called for by Reissue Patent 19,117. It has been pointed out that respondent

ent always used a cold cutting punch (p. 10 of this brief). The petitioner's own witnesses said that it did not between 1930 and 1934 use a heated cutting punch (p. 134 Rec.) and the District Court so found (p. 2081 Rec.).

There is thus a finding of fact by the Circuit Court of Appeals based on adequate evidence and upon the only construction that could be made of the claims of Re-issue patent No. 19,117. It is submitted that certiorari should not be granted to review solely that question of fact. That it is the well settled practice of this court not to review questions of fact on Certiorari is demonstrated by the case of *Maytag Company vs. Brooklyn Edison Co., Inc.* page VIII, No. 654 where the Court of Appeals reversed the District Court on the question of validity and the case of *United Chromium, Inc. vs. General Motors Corp.*, page XI, No. 733, where the Circuit Court of Appeals reversed the District Court on the question of priority of invention and *Perey Mfg. Co. Inc., et al. v. Tulchen*, XI No. 746, where the Circuit Court of Appeals reversed the District Court on the question of infringement. 299 U. S. (Advance sheets).

The subject matter of the claims in Warth patent 1,967,195 was completely and voluntarily dedicated to the public by Warth.

The record shows that when the Warth application for a method of applying a center spot to crown caps by heat and pressure was applied for on January 7th, 1927, Serial No. 159,743, the use of a heated plunger was disclosed (p. 1490 Rec.) It also contained the following statement:

"It may be desirable to secure the metal foil spot in position prior to the heat and pressure steps, sufficiently to prevent dislodgement of the spot during any interval between assembling and final sticking. This may be accomplished, for example, by preheating the assembled crown to soften the coating as soon as the metal foil spot is deposited. Or the coating may be softened by moistening slightly with a solvent, such as benzol. In

either case the coating becomes tacky enough to hold the metal foil spot from getting out of position during ordinary passage through assembling apparatus."

It originally had claims for a method including coating metal foil with an adhesive rendered soft by heat and applying heat and pressure by means of a heated plunger and or by preliminarily heating the cork. It also had two product claims for an adhesive, which were cancelled on a requirement for division. All the method claims were rejected in an Office letter dated January 11th, 1929 (p. 1497 Rec.) The Office letter stated that the method claims were "rejected on any of the references cited which disclose the coating of a metallic foil with an adhesive which is rendered soft by heat, applying the coated metal to cork and holding under pressure until the adhesive hardens." That letter also required a drawing if any claims were subsequently found allowable. The case was amended (p. 1498 Rec.) by cancelling claims 1, 4 and 6 and limiting one of the claims by inserting "cutting a facing spot from coated foil". The amendment stated (p. 1499 Rec.):

"The Examiner states that any of the references discloses the use of an adhesive rendered soft by heat and applying under pressure. But applicant is not claiming anything so broad as that."

The case was then finally rejected, and an appeal taken (pp. 1500-1 Rec.) Attention is called to the Examiner's statement (pp. 1502-3 Rec.) It will be noted the Patent Office, in its rejections made no distinction between the two methods by one of which the heat was applied to the cutting plunger and the other for preliminarily heating the cork, but rejected both methods. On December 3rd, 1930, after an interview with the Examiner (p. 1508 Rec.) all the claims were cancelled. The application being almost entirely rewritten (pp. 1509 to 1518), the claims all cancelled and one specific claim inserted, limiting the method to "upon assembly applying

simultaneously to the spot, pressure and sufficient heat to render the adhesive tacky."

It will be noted that the amendment also voluntarily cancelled the matter we have quoted at page 12 brief, supra as to the pre-heating of the assembled crown. With the amendment a drawing was filed showing a heated plunger. After an amendment under rule 78 was made inserting another claim, which was the same as the one claim allowed with the exception that it was limited to a metal foil spot (pp. 1530-1 Rec.) the application was allowed and the patent was issued on January 6th, 1931, bearing number 1,788,260 (the parent of the reissue 19,117): The issued patent 1,788,260 had no disclosure of and made no reference to preliminarily heating the cork.

Obviously, when the patent issued it was open to the public and any member of the public interested in the patent could look at the Patent Office file history and see that the patentee had abandoned and dedicated to the public, both the subject matter and the claims for the method of obtaining the necessary heat by preheating the cork. There can be no clearer case of voluntary dedication to the public of this method than the action of the patentee in this instance.

Patent 1,967,195 contains the statement that the original application was filed on November 7, 1930, Serial No. 494,201, which in turn is a division of Serial 159,743, January 7, 1927, now patent 1,788,260, dated Jan. 6th, 1931.

It is true that Serial No. 494,201 filed on November 30th does contain the disclosure as to preliminary heating the cork which was cancelled from the parent application of January 7th, 1927, #159,743. The District Court held, and petitioner argues, that because an application containing a disclosure of the method in connection with an entirely different invention, but making no claims to the method per se, or any method of any kind, was in the Patent Office at the time of filing the application of April 4th, 1933, which resulted in patent 1,967,195, the patentee Warth was entitled

to the date of January 7th 1927 when he first filed an application claiming that disclosure.

There are two complete answers to that erroneous holding of the District Court and the contention of petitioner in attempting to uphold it. The first answer is that, as above pointed out, when the parent patent 1,788,260 issued and became public on Jan. 6th 1931, the file shows that the pre-heating method and claims therefor had been abandoned and the patentee had elected to take claims for the narrow and specific method of applying heat to the plunger.

The second answer is that the application Serial No. 494,201 was for an entirely different invention. It is not an application for a patent on a method at all. The application 494,201 (p. 1948 Rec.) states that it is for an improvement in "Bottle Cap Spot Material". It appears from the specification (p. 1950-2 Rec.) that the alleged invention consisted of coating a strip of tin foil or aluminum foil with a heat fusible adhesive. There was one claim which read in part

"As a new article of manufacture, highly flexible laminated material in sheet or strip form for the spotting of cushion disks, etc."

The claim was rejected as obviously met by a number of prior art patents, (pp. 1955-6 Rec.) and the Office action said

"This case appears devoid of invention and should be prepared for a final action."

The case was amended and a drawing inserted showing the method of putting the adhesive on the strip material.

The drawing also showed and the amendment stated (p. 1964 Rec.) that the heat for softening the material was to be attained by maintaining the cutting punch 20 at an elevated temperature. The drawing so far as the heating method is concerned was the same as that shown in reissue 19,117.

On pages 1968-9 Record ten advantages were enumerated for the invention, most of which were to show the great desirability of applying the adhesive by coating it on the

strip material instead of feeding a separate sheet of cap material and a separate sheet of gutta percha tissue as had previously been done. The tenth advantage claimed (p. 1969 Rec.) was

"The heat and pressure necessary for uniting the facing to the cap may be applied substantially simultaneously with the punching and assembly operations, etc."

The case was again rejected, (p. 1972) the office letter stating that it should be prepared for final action. It will thus be seen that in application 494,201 which is relied upon by petitioner to show that the matter was still before the Patent Office, the applicant again illustrated and described *the heated plunger. He did not urge or mention the desirability of preheating the cork.*

It is further significant that the applicant in an amendment (p. 1969 Rec.) dated June 16, 1931, after patent 1,788,260 had issued on Jan. 6, 1931 for the method, stated:

"As a further feature of the invention, the applicant proceeded to provide a method involving the use of this article. However, the article is the basis for the method. Protection having been granted for the method, it is thought that the same argument which supports the patentability of the method, applies with much greater force to the article, without which the method could not have been provided."

The claims were again rejected (p. 1972). Thereafter, amendments were made with other claims and finally the application was allowed on Feb. 1st 1933 (p. 1984 Rec.) with two claims. One of the claims was cancelled and transferred to the application for such strip material patent 1,899,782 held invalid by the District Court. The case was allowed to lapse for non-payment of fee and was renewed on Feb. 1st 1934 with other claims put in and it was again allowed on Oct. 5, 1934 (p. 2000 Rec.) but the patent was never issued and counsel for respondent on February 14th 1935, had to apply to the Commissioner to obtain a copy of the application and the re-

quest was acquiesced in by counsel for petitioner (pp. 2005-6 Rec.).

When the Johnson patent was ready for issue there was no application pending in the United States Patent Office containing claims conflicting with the method claims of the application for that patent, No. 1,852,578.

When Warth filed the application on April 4th 1933 for the patent which resulted in #1,976,195, his attorneys wrote a letter to the Patent Office stating that (p. 1686 Rec.):

"It is to be noted that the issued patent (1,788,260 on which the reissue was founded) does not disclose the preheating of the crown or pad within the crown."

Despite that statement, petitioner now asserts in this Court, that reissue of Patent No. 1,788,260 embraces the very feature admitted not to be disclosed in that patent or reissue, and asks that the claims be construed to cover a feature not disclosed in the patent, and which was deliberately cancelled from the application therefor.

Directoplate v. Donaldson Lith. Co., 51 F. R. (2) 199;

Rosenberg et al v. Carr Fastener Co., 51 F. R. (2) 1014 Cert. Denied 284 U. S. 652.

A divisional application cannot be obtained after the Parent case issues. They must be co-pending.

The assertion by petitioner on pages 3 and 5 of the petition that the decision of the Circuit Court of Appeals for the 2nd Circuit, in this case, reverses the accepted practice in the Patent Office, is not warranted. That practice is clearly defined in the case of *Fessenden vs. Wilson et al.*, 48 F. R. (2d) 422, (Ct. Cust. & Pat. App.) where the Court said at page 424:

"We agree with the Board's finding as follows: 'Fessenden's earlier application became a patent May 14,

1918, and the patent contained no disclosure of the invention claimed in Fessenden's later application. There was an interim of more than three years between the grant of the patent upon the earlier application and the filing of the later application. The later application cannot have the benefit of the date of the earlier application as a continuation thereof. The proceeding relating to the two must be in fact continuous. *Sarfert v. Meyer*, 1902 C. D. 30. An application cannot be considered as a continuance of a patent granted prior to the filing thereof, since after the application has eventuated into a patent there is nothing left pending before the Patent Office upon which it could act or to which the later application could attach. *In re Spitteler*, 31 App. D. C. 271, 134 O. G. 1301; *Wainwright v. Parker*, 32 Add. D. C. 431, 142 O. G. 1115, 1909 C. D. 379.

The facts in the case quoted from are exactly like those in the case at bar. Warth's original patent 1,788,260, on which the reissue was founded, as previously pointed out, issued in 1931, with no disclosure or claims for the method of 1,967,195. The fact that the disclosure was still in the Patent Office in Serial No. 494,201 in no way affects the applicability of the law laid down in the cited case. Application 494,201 was for an entirely different invention, and no method of any kind was ever claimed in that application. When the original of the reissue issued an inspection of the file wrapper showed that the disclosure and claims for the method of preheating the cork was voluntarily cancelled from the application and the public had notice thereof.

The application upon which the Warth Patent 1,967,195 was granted could not be a division of application Serial No. 494,201 or 159,743 because the subject matter of application for patent 1,967,195 was voluntarily cancelled and abandoned in 159,743, and any assertion of a right to a patent upon the cancelled subject matter was not made until the filing of the application for Patent No. 1,967,195 more than two years after the issuance of Patent No. 1,788,260 granted upon application Serial No. 159,743. While such claims might have

been asserted at any time during the pendency of application Serial No. 159,743, they could not be asserted after the issuance of Patent No. 1,788,260, even by reissue and much less so by divisional application, because of abandonment of record of the subject matter.

If Reissue 19,117 is entitled to a construction of a scope to include preheating the cork disc as called for in patent 1,967,195, to sustain patent #1,967,195 would be to extend the monopoly. *Saranac Automatic Machine Co. vs. Wirebonds Patents Co. et al.*, 65 F. R. (2d) 904 (C. C. A. 6th) at 906, where the court refers to the prior decision of this Court in another case, involving the same patents reported in 282 U. S. 704 (see pp. 714-15).

In order for patent 1,967,195 to be entitled to the date of Jan. 7, 1927 (the application date of the original of the re-issue) the application for 1,967,195 would have to be filed before the issue of the first patent.

Gen. Motors Corporation v. Rulsam Corporation,
65 F. R. (2) 217 at 220 (C. C. A. 6);
In re Nathan, 279 F. R. 925.

The record shows a clear case of intervening rights.

Counsel for petitioner states in his petition and brief in support thereof (pp. 3, 17, 19) that there were no intervening rights other than the issue of the Johnson patent and the admitted use by petitioner in 1929 and calls attention to the fact that the District Court ignored respondent's use of the method patent 1,967,195 and that there is no express finding of the Court of Appeals to the contrary. Petitioner therefore argues that the doctrine of *Chapman vs. Wintroath* applies, because Warth, when he filed his application for 1,967,195 copied the claims of the Johnson patent within two years from the issuance thereof and thus comes within the principle of *Chapman v. Wintroath*.

While it is true the Circuit Court of Appeals made no specific finding on the question of intervening rights, it is very apparent that in applying the doctrine of *Webster vs. Splitdorf*, it based its decision on the facts in the record and necessarily found as a fact that there were intervening rights, without specifically saying so, otherwise it would not have reversed the District Court and applied the doctrine of *Webster vs. Splitdorf*. Obviously the Circuit Court of Appeals always goes into the facts in a patent case de novo.

Owing to the misleading statement by Petitioner on page 9 of his petition and brief, "Even in the absence of intervening adverse rights" it is necessary to briefly refer to so much of the record as shows that respondent, from 1928 up to the time of the trial, used the method of preheating the cork as claimed in the Warth patent 1,967,195.

Respondent bought its machines for center spotting caps from Johnson, beginning as early as July 1928 and ending in the Spring of 1933. The petitioner endeavored to show in the trial court that the first machine purchased by respondent from Johnson in 1928 did not have a device for preheating the cork and the District Court found that none of the machines purchased by respondent from Johnson had a preheater (p. 2100 Rec.).

There was conflicting evidence as to whether the first two machines bought by respondent from Johnson in July and August of 1928 had or had not the preheating device. We may assume for present purposes that they did not. It is proved, however, beyond all question, that the additional machines purchased by respondent from Johnson in September 1928, December 1928, March 30, 1929 and April 30th 1929 did have a preheating device for the reason that respondent's Exhibit Q (pp. 1102-3 Rec.) shows that each one of the bills to respondent from Johnson call for a number of features among which is "a roll feed etc.". The roll feed means "a spotting" attachment (p. 350 Rec.). The bills of Johnson for the July and August machines (Exhibits P

and S, pp. 1101 and 1108 Rec.) each call for one tin foil machine etc. Subsequently and between May 5th and June 19th 1933, respondent purchased four other machines from Johnson (Exhibit R, pp. 1104-7 Rec.). The center spotting machines were purchased from Johnson by respondent for the purpose of manufacturing center spot crowns having a metallic foil spot secured by gutta percha to meet a large commercial demand which arose about that time for center spots by brewers. Respondent received inquiries, and ultimately orders from the Goetz Brewery, one of the largest breweries in the country, for the production of crown caps for beer bottles with a center spot of metal foil (pp. 268-278 Rec.).

Mr. Ketterer, manager of the Goetz Brewery, a witness for respondent identified invoices for crown caps having a metal center spot, which respondent's witnesses said were made on Johnson center spot machines having the preheating device and secured by gutta percha, running continuously from August 1928 until November 1935 aggregating approximately one million gross of caps to that one customer. (Exs. NNN to TTT pp. 1763 to 1812.) In addition to that one customer, respondent sold a great number of center spot crowns made by a method including preheating the cork disc before the center spot was applied, to other customers. In 1930 and 1931 it sold carloads of crowns made by that method to the Welch Grape Juice Co. (pp. 318-19 Rec.).

That the spotting machines made and sold by Johnson to respondent the latter part of 1928 and in 1929 and 1930 had the preheating device is conclusively shown by the cross examination of Johnson by petitioner's counsel, at pages 237-8 of the Record, from which it appears that Johnson put the preheaters on the machine he had sold to Armstrong, on October 5th 1928. He said in answer to XQ 116:

"I took the heat out of the cutting punch altogether and installed two heaters in front of it, and also a space heater I installed before the tin foil disc was cut and inserted. And that kept the cutting punch cold."

In part of his answer to XQ 113 he said:

"And I put preheaters on it, and took out the heater in the cutting punch and heated the cork before the spot was inserted * * *"

That petitioner had actual knowledge of the use of machines for carrying out the method of preliminarily heating the cork covered by the claims of method patent 1,967,195 by respondent and others, is conclusively shown by its own act in copying the three method claims of the Johnson patent for the purpose of interference (p. 1686 R.) and the evidence adduced during the interference.

The issue of the interference was, of course, the three method claims of the Johnson patent, now the only claims of patent 1,967,195. A copy of Warth's preliminary statement does not appear in the record. A copy of the preliminary statement of Johnson is found on pages 2043-4 of the record, from which it appears that he constructed a full sized apparatus for carrying out the invention during the fall of 1927 and sixteen apparatus for carrying out the invention of the issue had been constructed.

When Warth got into interference he, of course, knew that he had to go back of Johnson's filing date of November 26th 1929 and Warth therefore alleged as reduction to practice the date of his application Serial No. 159,743, for the patent resulting in 1,788,260, the parent of reissue 19,117. As has been pointed out, the step of preheating the cork, shown in 159,743 was cancelled from that application on December 3, 1930.

At the beginning of the interference Warth made a motion to shift the burden of proof in an effort to obtain the date of filing of 159,743, viz Jan. 7th, 1927. The motion was denied by the Examiner of Interferences on the ground that the Jan. 1927 application of Warth did not contain a disclosure sufficient to support the counts (pp. 438-9 Rec.). Johnson also filed a Public Use Proceeding from which it appeared that machines for carrying out the method of his patent were

made and sold and in public use more than two years prior to April 4th 1933, (when Warth filed the application for patent 1,967,195) by several persons, among whom was the respondent, the Arrow Bottle Cap Corp. of Brooklyn and the Crown Cork & Seal Co. Inc., the petitioner herein (p. 1130 Rec.). Johnson's petition for Public Use Proceedings was corroborated by a number of affidavits found at pages 1133 to 1148 Rec.

After the decision of the Examiner of Interferences denying Warth's motion to shift the burden of proof, the Petitioner on December 12th, 1933, purchased the Johnson patent and took an assignment thereof (pp. 226, 1162 Rec.). The assignment was never recorded (p. 610 Rec.). After the purchase by petitioner of the Johnson patent the interference was still continued and a stipulated record consisting of affidavits made by Warth and two others was made up for the purpose of final hearing and appeal (p. 1890 Rec.). On that stipulated record the Examiner of Interferences reversed his prior decision and awarded priority to Warth. Counsel for Johnson filed no brief at final hearing (p. 576 Rec.). All papers filed by Johnson in the public use proceeding were withdrawn from the Patent Office by petitioner after petitioner purchased the patent from Johnson (pp. 227-9 Rec.).

Defendant's Exhibit T (1109 to 1120), shows bills running between March 1929 to July 31, 1929 for five tin foil spotting machines sold and delivered by Johnson to Petitioner. One invoice calls for "foil cutting dies for tin foil machine." Attention is called to page 1112, which shows a letter dated Feb. 27, 1929 from petitioner to Johnson stating:

"Referring to your conversation and correspondence with our Dr. Warth, would suggest that you send us on approval the machine for adhering the gutta percha lining to the tin foil. Also the machine for cutting the tin foil and fastening the same to the cork washer on finished crowns."

The petitioner's vice president, Fusting, and its superintendent Goebel admitted the purchase of these machines

at the times mentioned (p. 683 Rec.). They said they were purchased for their Canadian plant. Nevertheless the Invoices show and both of the witnesses above mentioned admitted, that the machines were shipped from Johnson's plant in Brooklyn to petitioner's plant in Baltimore, Maryland. That the machines were there "tuned up" for shipment to the Canadian plant (p. 554 Rec.). Petitioner's own act in buying these Johnson machines inspecting them and sending them to Canada (if it did send them to Canada) shows public use by Petitioner itself, slightly more than four years before Warth filed his application for patent No. 1,967,195, on April 4, 1933. When it is considered that respondent sold caps made by the method covered by the method claims of the Johnson patent (which are now the only claims in Warth patent 1,967,195) in large quantities to various customers continuously from 1928 up to and including the time of trial, and that Johnson's public use petition shows the manufacture and sale of machines made and designed for carrying out the method of the claims under discussion, which petition is corroborated not only by the accompanying affidavits but the admitted purchase by petitioner of such machines in 1929, it is submitted that there can be no clearer case of public use and intervening rights than is shown by the record of this case. No question was raised by petitioner's witnesses as to the fact that the five machines shipped to it by Johnson to Baltimore had the means for preheating the cork. The letter to Warth dated February 27th, 1929 (p. 23, *supra*), asking that machines be sent on approval completely negatives any possibility of that question being raised. Furthermore it is negated by Johnson's testimony on cross examination referred to on pages 21-22, *supra* to the effect that in Oct. 1928 he did away with heating the plunger and heated the cork instead.

We thus have a case where an applicant for a patent made a disclosure in his application as filed. He voluntarily, without any requirement of the Patent Office, cancels the dis-

closure and the claims covering that disclosure. Before cancellation he files another application for an article with utterly different subject matter which has the *disclosure* in the pending application but he *does not* claim it. He has absolute knowledge before cancelling the disclosure that a third party has made and sold and in fact the applicant's assignee has bought machines from that third party for carrying out the method covered by the disclosure and claims as originally filed. The applicant, more than three years after voluntarily cancelling the disclosure and claims for the matter in controversy, and after actual knowledge of the subject matter of the claims in a patent issued to the man from whom his assignee by his order had bought machines from Johnson the patentee, for the purpose of carrying out the method then files an application claiming that which he had originally disclosed and voluntarily cancelled and which for some four years had been in public use and on sale.

The record therefore shows that the case of *Webster vs. Splitdorf* cited by the Circuit Court of Appeals in its decision clearly applies. There could be no clearer case for its application than the case at bar.

Quite apart from the decision of *Webster v. Splitdorf*, this Court has many times held that in a case where a patentee has delayed asserting his rights and intervening rights have accrued, the patentee will be barred from later asserting those rights. In the case of *Railway Co. v. Sayles*, 97 U. S. 554, 563, this Court said:

"Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the mean time, gone into public use."

In the case of *Victor Talking Machine Co. v. Brunswick-Balke-Collender Co. et al.*, 8 Fed. 2d 41 (C. C. A. 3rd), the Court said:

"On April 4, 1911, Browning struck from his application for the patent the invention covered by claim 1, and did not reinsert it until June, 1915. Judge Morris held that this unexplained silence for a period of more than four years constituted an abandonment by him of the invention. We think his conclusions on both issues are sound, and affirm the decree on his opinion."

That decision was affirmed by this Court. *Per Curiam*, 273 U. S. 671;

Planing Machine Co. v. Keith, 101 U. S. 479 at 485;
Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92;
Yale Lock Co. v. Berkshire Bank, 135 U. S. 342 at 378-9;

Rubenstein v. Slobotkin, 33 F. R. (2) 603 at 608.

It is well settled that where an applicant delays his application in the Patent Office for a long while and then puts in claims which cover improvements that have appeared in the art and patents issued therefor in the meantime, he cannot amend or broaden his claims to cover such devices. Typical cases are *Irving Air Chute Co. v. Switlick Parachute & Equip. Co.*, 82 F. R. 2d 645 (C. C. A. 3rd Circuit); *T. H. Symington & Son, Inc. v. Symington Co.*, 9 Fed. Supp. 699 at 704; *Insulate Co. v. Reserve Supply Co.*, 60 Fed. 2d 433, 435 (C. C. 8), *Hartford Empire Co. v. Coe*, 76 F. R. (2) 426.

Such being the law, it is clear beyond question that petitioner in this case having cancelled the method of preheating the cork in his 1927 application for patent and allowed the patent to issue thereon without that disclosure, cannot come in three and one-half years thereafter, when a patent has been issued to Johnson for the matter cancelled and the subject has been in use by Johnson, the respondent in this case as well as the Petitioner and others and obtain a valid patent for the cancelled subject matter.

Petitioner is licensed to use the method and machine of Johnson Patent 1,852,578.

Under U. S. R. S. 4899 petitioner is licensed to use the machine of the Johnson Patent 1,852,578 and to carry out the method set forth in the method claims of that patent.

Respondent bought all of its machines from Johnson between August, 1928 and the spring of 1933. Some of these machines were purchased after the issuance of the Johnson patent No. 1,852,578 (pp. 1102-7 Rec., Vol. 2: Test. Johnson, pp. 222-3 Rec.). By the purchase of these machines, respondent acquired the right to their use from the patentee. The Johnson patent contained 27 claims to the machine and three claims to the method or function of the mechanism of the machine.

Prior to the filing of the application for public use proceedings, by Johnson, and in August, 1933 (pp. 301, 379), petitioner's vice-president and its counsel visited the plant of the respondent and saw a Johnson machine in operation. On December 12th, 1933, petitioner purchased the Johnson patent and took an assignment thereof (pp. 1162-3 Rec., Vol. 2) and, on the same date executed a license to Johnson which license set forth that it was on that date the owner of the Johnson patent and gave Johnson a release for all past infringements of the Johnson patent (p. 1157 Rec.).

The petitioner took title to the Johnson patent with full knowledge that the respondent was using such machines and no subsequent proceeding in the Patent Office can divest the respondent of the rights its acquired from Johnson to use the machines, **particularly when the petitioner does not contest the inventorship of Johnson of the apparatus claims of the machines.**

Keystone Type Foundry vs. Fastpress Co., 272 Fed. 242;

Dable Grain Shovel Company v. Flint, 137 U. S. 41;

DeForest Radio Telephone Company v. United States, 273 U. S. 236.

The record shows that there were intervening rights and a public use of the method of patent 1,967,195. The facts constituting such intervening rights and such public use were known to petitioner long prior to the filing of the application by Warth for such patent and before the purchase by petitioner of the Johnson patent and the subsequent allowance of the method claims of that patent in the Warth application. This procedure obviously was solely for the purpose of divesting respondent of those rights acquired by the purchase from Johnson of machines for the practice of the method.

Petitioner, by thus buying the Johnson patent and having the claims allowed in patent (1,967,195) granted more than two years after the issue of the Johnson patent, has not only prolonged the life of the monopoly as to the method, but has prolonged the life of the Johnson patent which it owns.

The Johnson patent, with its apparatus and method claims, nominally would have expired in April, 1949, and if the Warth patent 1,967,195 is valid, the Johnson patent, as to the apparatus claims, while nominally expiring in 1949, will in fact be extended to July, 1951, since this apparatus cannot be used without infringing the method claims of the Warth patent 1,967,195.

The effort to conceal the fact of ownership of the Johnson patent obviously was an effort to withhold a material fact from the public.

Keystone Driller v. General Excavator Co., 290 U. S. 240.

There is no conflict of decisions.

Counsel for petitioner has cited a number of authorities and argued that there is a conflict of decisions between the Circuit Courts of Appeal of different circuits. It is unnecessary to discuss those cited decisions in detail. No one of them shows a state of facts as shown by this record, viz. claims and disclosure having been stricken from a pending application, the patent issued and then more than two years after its

issuance the inventor tries to get that cancelled and abandoned matter which has gone into public use, into another patent and get the date of the original.

Counsel for petitioner evidently overlooks the fact that the case of *Wirebounds Patents Co. vs. Saranac Automatic Machine Co.*, 37 F. (2) 830 relied on by him at pages 5, 12, 19 of his brief was reversed by this Court in 282 U. S. 704. It would seem that if any conclusion could be drawn from the action of this court, it is that the decision of the lower court in that case 24 Fed. (2) 872 is the law. That court properly applied the doctrine of *Webster Electric Co. vs. Splitdorf Electric Co.*, because there was a long delay in filing a divisional application and as in the case at bar there was no evidence of inadvertence, accident or mistake.

It will be noted therefore that on an analogous state of facts to those in the case at bar, this Court refused to pass on the question now attempted to be raised by petitioner. Manifestly, there is no conflict between the decisions of the Second and Sixth Circuits.

The fact that the patentee thought or was informed his claims covered both forms of the invention is no excuse.

Counsel for petitioner cites on page 28 of his brief, two cases to the effect that reliance on an earlier application or patent is an excuse for delay in asserting claims. The two cases cited there are both interference decisions and show an entirely different state of facts than that shown in this record.

In any event, this court has held that the opinion of a patentee or his counsel, to the effect that an earlier patent covered a certain construction is no excuse for delay.

Wollensak vs. Sargent, 151 U. S. 221 and cases cited.

McClain vs. Ortmyer, 141 U. S. 419.

Radio Condenser Co. et al. v. Coe, 75 F. R. (2) 523.

The case of *Chapman vs. Wintroath*, 252 U. S. page 126 has no application to the facts disclosed by this record.

In *Chapman vs. Wintroath*, the Chapmans disclosed the invention in controversy but did not claim it. Thereafter Wintroath filed an application and obtained a patent on the subject matter of the invention. Afterwards, while Chapman's original application disclosing the subject matter was still pending, they filed a divisional application within two years from the issue of the Wintroath patent and copied Wintroath's claims. It was held they could do it because they had originally disclosed it in a pending application. There are no such facts or even remotely analogous facts in the record of this case. In the case at bar, Warth deliberately cancelled the matter, as has been previously pointed out and his patent issued without disclosing or claiming the cancelled matter, and the cancelled matter was dedicated to the public when his original patent issued in 1931, the file of which shows that matter had been cancelled.

This court in *Chapman vs. Wintroath* did not lay down any hard and fixed rule to the effect that if a patent issued to another party while an application was pending the applicant could, in every case, as a matter of right copy the claims of the issued patent for interference purposes. On the contrary it expressly provided that there might be cases where even if an application was filed within the two years it would not be in time depending on the circumstances of each case. This court said on page 139:

"While not intending to intimate that there may not be abandonment which might bar an application within the two-year period allowed for filing, yet upon this discussion of the statutes and decisions etc."

As previously pointed out, the case at bar is one of deliberate abandonment. There are intervening rights of third parties. The subject matter had been cancelled from the appli-

cation (159,743) the date of which petitioner seeks to obtain and the patent had issued on that application.

Obviously *Chapman v. Wintroath* has no application to the case at bar.

The invention claimed in both of the patents in controversy is merely for a function and not patentable.

The claims of both Warth patents, Re-issue 19,117 and 1,967,195 are for a *method*. No complete apparatus or machine for carrying out the method is shown, described or claimed. The claims in both of these patents are for a method of securing a center spot by means of a heat fusible adhesive with a cork disk by means of heat and pressure. The claims are for nothing but the function of a machine. Obviously when using a heat fusible adhesive, heat and pressure must be used.

It is well settled by many decisions of this and other Courts that a patent for a result or function cannot be sustained.

Westinghouse Air Brake Co. v. Boyden, 170 U. S. 537 at pages 555-8;

E. Van Norden Co. v. Cheney, 75 Fed. 298 (C. C. A. 1) at page 302;

Directoplate v. Donaldson Lith. Co., 51 F. R. (2d) 199;

DeForest Radio Co. v. General Electric Co., 283 U. S. 664, pages 682-4.

CONCLUSION.

There is nothing in the record to warrant the exercise by this Court of its discretionary power of review.

The facts in the record do not support the questions presented by petitioner on page 9 of its brief.

The question of infringement of Re-issue patent No. 19,117 is purely one of fact.

The construction placed by the Circuit Court of Appeals upon the claims of Re-issue Patent No. 19,117 is fully supported by the file history of the application for that patent and the facts in the Record.

Patent No. 1,967,195 is invalid for the reason that the subject of the claims thereof was cancelled and abandoned to the public by Warth when he cancelled the description and claims from his application Serial No. 159,743 (the date of which he now seeks to obtain) and thereafter permitted Patent No. 1,788,260 to issue on January 6th, 1929 and permitted the public to acquire knowledge of such cancellation. In the meantime respondent and others had used the method to a large extent commercially.

The Record shows a clear case of intervening rights and the Circuit Court of Appeals properly applied the doctrine enunciated by this Court in *Webster v. Splitdorf* to the facts shown in this Record.

The Petition should be in all respects denied.

Dated, New York, N. Y., June 30th, 1937.

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